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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/004,296
Filing Date: October 31, 2001
Appellant(s): BENSON, THOMAS D.

Jody Bishop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/10/2006 appealing from the Office action mailed 10/7/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6816839	Gung et al.	11/2004
H1743	Graves et al.	September 26 1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the term "performance" is being used. The term would seem to connote use of quality or standards but nothing has been recited to quantify this term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21,22,24 are rejected under 35 U.S.C. 102(b) as being anticipated by Graves et al.

Graves et al. disclose code which processes a processor operable to determine a required quantity of material (processing unit 106); a means for communicating with at

least one supplier of said material (voice card, modem interface or facsimile col. 7 lines 1-15), wherein said communication includes conveying to said at least one supplier said quantity and a time frame (col. 6 lines 53-55 purchase order releases are scheduled) and receiving from said at least one supplier a confirmation (col. 7. lines 7-10, supplier confirms shipments); computer readable code processed by said processor (106), wherein said code is operable to re-determine said required quantity using feedback relating to a performance of at least one supply chain participant (one supply chain participant is read as the customer and its "performance" is read the functioning of the facility which as a result draws down on the tank supply (see col. 17, lines 28-37 for feedback feature) .

RE claim 22. see col. 17 lines 28-30 for disclosure of the feedback includes a comparison between an actual run rate and a corresponding anticipated run rate.

Re claim 24: see col. 17 lines 30-31, discloses is a product forecast.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al (H1743) in view of Gung et al.

As set forth above, Graves et al. discloses the subject matter of claims 22,23, and 24, but applicant challenges the use of performance in graves et al. as a standard for forecasting supply. However, Gung et al. in col. 3 lines 16-19 discloses forecasting demand based upon performance. It would be obvious to modify the Graves to use a performance factor to determine supply forecasting because factors, such as, transportation reliability, and raw material availability would be considered. Such raw material availability (production yield) would be an obvious standard for comparison in the feedback system because the motivation for this would be a basic standard which need to be met (re: claim 24). That is, it is common knowledge that in a feed back system there must exist a standard or threshold against which the feedback signals are compared. It is contemplated to use the model based value of Gung to set the threshold of the feed back system in Graves to make it have a more efficient target.

(10) Response to Argument

Rejection based on 112 2d Paragraph

As will become apparent, this appeal rests on the interpretation of the term "performance". The breadth Appellant gives to this term far exceeds what it deserves relative to the prior art. Appellant attempts to define the term on page 4 of his brief as "run rate information" but here too he has confused the issue. Page 5 of the specification, on line 4, an actual run rate and an anticipated run rate are both used. I f Appellant is attempting to clarify, then which run rate information is it? Is the information related to actual run rate or anticipated run rate? Further, nowhere on page 5 of the specification referenced by Appellant in his brief as providing the definition for "performance" is the word "performance", used. Thus, the Board should realize that Appellant's use of the term "performance" causes confusion in the minds of the reader in that the term cannot even be found in the specification where Appellant alleges a clear definition exits. Moreover, the term has been repeated denied by Appellant as "not limited to any one specific standard or quality" (Brief page 4). Thus, Appellant rather than moving in a direction to more clearly define the term, in fact intentionally clouds the definition to strip it of any inherent standard or quality which it might posses to reasonable person. This type of practice cannot be condoned by the Board, because if this were to be the case, then the pubic would never be certain of the scope of any claim asserted. *See,* Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1374; 58 U.S.P.Q.2D (BNA) 1508, April 20, 2001, (CAFC).

Rejection of Claims 21,22, 24 Under 35 USC 102b As Anticipated by Graves et al.

The sole issue raised by Appellant and to be decided by the Board under the 102 rejection is whether "performance" occurs in Graves et al (hereinafter Graves). In Graves "one supply chain participant is read as the customer and its "performance" is read the functioning of the facility which as a result draws down on the tank supply (see Graves H1743, col. 17, lines 28-37 for feedback feature" see office action dated 10/7/05). Claim 1 makes no qualification for who or what the at least one supply chain participant is. Thus, the examiner has read the supply chain participant as the customer storage facility in Graves. The customer is a participant in the supply chain because he is a recipient within the context of this chain. Thus, the customer facility in Graves answers to the limitation of an "at least one supply chain participant". See, In re Cortright, 165 F.3d 1353, 1358, 49 U.S.P.Q.2D (BNA) 1464, 1467 (Fed. Cir. 1999) citing to, In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (" [T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art ....").

It is submitted that the customer facility in Graves is "performance" based because it is a paper mill (see col. 5 lines 3-5) which makes product i.e., paper. As more paper is produced by the facility, e.g. performance, the more chemical in the storage tank 102

is used as a result of this performance. This performance based usage is disclosed as being monitored to determine a required quantity namely, a projected storage tank level (col. 17 line 29).

The dictionary definition of "performance" is:

> Merriam Webster's Collegiate Dictionary 10th Ed. Defines as it as 1 a: the execution of an action. b something accomplished.

Regardless of what the purpose of the drawing down of the chemical in Graves is, based on this definition alone, the simple removal of chemical from the tank is clearly the execution of an action, namely, the taking out of a product. Even still, the additional aspect of using the drawn down chemical to directly produce paper clearly is related to performance.

Dependent claim 22 seeks patent coverage on a feedback feature which compares actual run rate versus an anticipate run rate; but Graves at (col. 17, line 28-33) disclose a feedback wherein a comparison e.g. "a projected storage tank level is compared to the actual level once every three hours" is made. Moreover feedback does occur when recalculation of projected levels of the supply based on the most recent flow rate is effected. This is a classic feedback situation.

Dependent claim 24 seeks to obtain patent coverage based, inter alia, on the argument "Graves is wholly silent as to any computer code" (brief at p.6). This is an unfortunate argument in that the Examiner must expend time and energy responding to a statement challenging a known principle of computer operation. But, for completeness sake, it is noted Graves discloses a processing unit 106 i.e. a computer which is controlled by code. More important is that claim 24 can be satisfied by any one of a determination made by 1. product forecast, 2. bill of material, 3. lead time and 4. desired inventory level. Graves in col. 17 lines 34 and 34 discloses maintaining a desired storage level which clearly meets inventory level limitation.

For these reasons the 35 USC 102 (b) rejection under Graves et al must be maintained.

The Rejection of Claims 21-24 Under 35 U.S.C. 103(a) as being unpatentable over Graves et al (H1743) in view of Gung et al. is Proper and Should be sustained.

The argument as to whether Graves discloses "performance" does not exist in the 103 rejection because the secondary reference to Gung manifestly discloses demand as a function of performance. (See, col. 3 lines 15-20.) Appellant argues that statistical forecast in Gung "is largely based on abstract, speculative values". However, Gung in line 19 of col. 3 clearly references performance as one variable which is used in

forecasting demand. Albeit, the disclosed performance is that of the competitors, but this nevertheless suggests that in a competitive market place, performance must be accounted for by all involved in the supply chain. Based on this teaching, common sense/knowledge would dictate that within a supply chain, such as found in Graves, the performance of any participant have some effect on another participant be it supplier or customer, and thus need to be accounted for based on the teach in Gung. It is well understood that the motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 80 USPQ2d 1641, 464 F.3d 1356 (CAFC 2006) at 7, 8; *citing to*, *In re Dembiczak*, 175 F.3d 994, 999 [50 USPQ2d 1614] (Fed. Cir. 1999). As we explained in *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 [43 USPQ2d 1481] (Fed. Cir. 1997), "there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art."

Appellant's argue Gung fails to disclose the feature of redetermining the required quantity using feedback relating to a performance of at least one supply chain participant. This argument makes no sense because this feature is found in Graves and it is not the examiner's intention that it be found in the secondary reference. Gung

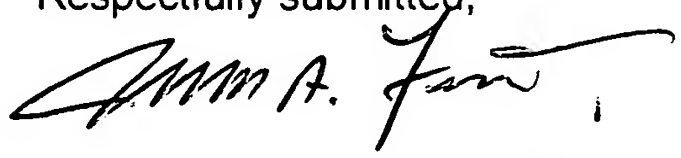
is used for the general teaching of performance as one variable used in forecasting demand in Graves et al.

No additional arguments are made for the subject matter of claims 22, 23 and 24, and thus they rise and fall with the determination of claim 21 herein.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Joseph A. Fischetti, JD, LLM
Primary Business Methods Examiner, 3627

Conferees:

Ryan Zeender 

Vincent Millin